

**REMARKS****INTRODUCTION:**

In accordance with the foregoing, claims 1, 13, 20, and 21 have been amended, and claims 7 and 18 have been cancelled without prejudice or disclaimer. No new matter is being presented, and approval and entry are respectfully requested.

Claims 1-6, 8-17 and 19-21 are pending and under consideration. Reconsideration is respectfully requested.

**ENTRY OF RESPONSE UNDER 37 C.F.R. §1.116:**

Applicant requests entry of this Rule 116 Response and Request for Reconsideration because:

- (a) at least certain of the rejected claims have been canceled, thereby at least reducing the issues for appeal;
- (b) it is believed that the amendments of claims 1, 13, 20, and 21 put this application into condition for allowance;
- (c) the amendments were not earlier presented because the Applicant believed in good faith that the cited prior art did not disclose the present invention as previously claimed;
- (d) the amendments of claims 1, 13, 20, and 21 should not entail any further search by the Examiner since no new features are being added or no new issues are being raised; and/or
- (e) the amendments place the application at least into a better form for appeal. No new features or new issues are being raised.

The Manual of Patent Examining Procedures sets forth in §714.12 that "[a]ny amendment that would place the case either in condition for allowance or in better form for appeal may be entered." ( Underlining added for emphasis) Moreover, §714.13 sets forth that "[t]he Proposed Amendment should be given sufficient consideration to determine whether the claims are in condition for allowance and/or whether the issues on appeal are simplified." The Manual of Patent Examining Procedures further articulates that the reason for any non-entry should be explained expressly in the Advisory Action.

**COMMENTS RE EXAMINER'S RESPONSE TO ARGUMENTS:**

Independent claims 1, 13, 20, and 21 have been amended to show more clearly differences between the cited art and the present claimed invention, as described more fully below. In view of the amendments to claims 1, 13, 20, and 21, it is respectfully submitted that

the present claimed invention is patentable over the cited art.

### **REJECTION UNDER 35 U.S.C. §102:**

In the Office Action, at page 5, numbered paragraph 13, claims 1-6, 8-17, and 19-21 were rejected under 35 U.S.C. §102(b) as being anticipated by Ohyama et al. (USPN 5,751,373; hereafter, Ohyama). This rejection is traversed and reconsideration is requested.

Independent claims 1, 13, 20, and 21 have been amended. The amendments are based, for example, on the contents described at lines 1-2 in paragraph [0020], lines 3-4 in paragraph [0021], lines 1-4 in paragraph [0026], and lines 1-3 in paragraph [0028].

It is respectfully submitted that the functions of an image processing apparatus according to the present invention are classified into a major function and an additional function according to the frequency of use. The major function is directly controlled using function buttons on a remote control while the additional function is controlled based on additional function information stored in a memory unit of the image processing apparatus by displaying the stored additional function information. Thus, an increase in the number of function buttons of the remote control can be avoided by using the additional function of the image processing apparatus.

Ohyama, however, does not disclose the above technical feature for the functions of an image processing apparatus based on the major function and the additional function according to the frequency of use.

In addition, it is respectfully submitted that the court has held that an anticipating reference "must disclose every element of the challenged claim and enable one skilled in the art to make the anticipating subject matter." PPG Industries, Inc. v. Guardian Industries Corp., 75 F.3d 1558, 1566, 37 USPQ2d 1618, 1624 (Fed. Cir. 1996).

Anticipation requires a lack of novelty of the invention as claimed. The invention must have been known to the art in the detail of the claim; that is, all of the elements and limitations of the claim must be shown in a single prior reference, arranged as in the claim. See C.R. Bard, Inc. v. M3 Systems, Inc., 157 F3d 1340, 1349, 48 USPQ2d 1225, 1229-30 (Fed. Cir. 1998); Richardson v. Suzuki Motor Co., 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

It is respectfully submitted that Ohyama et al. recites different operations than are recited in independent claims 1, 13, 20 and 21 of the present invention.

For example, a comparison of independent claim 1 of Ohyama, it recites:

1. A function selection method for a television receiver comprising the steps of:

displaying a first level of a hierarchical menu in a first region of a screen of said television

receiver, wherein a plurality of selection items corresponding to functions of said television receiver are displayed; (emphasis added)

designating one of said plurality of selection items from said first level of said hierarchical menu displayed on said screen of said television receiver; (emphasis added)

displaying a subordinate level of said hierarchical menu in a second region of said screen, wherein a plurality of control items corresponding to said designated selection item are displayed; (emphasis added)

selecting said designated selection item of said first level of said hierarchical menu; (emphasis added)

selecting one of said plurality of control items from said subordinate level of said hierarchical menu; and (emphasis added)

modifying said selected control item, whereby said functions of said television receiver corresponding to said designated selection item is controlled by modifying said selected control item. (emphasis added)

In contrast, amended claim 13 of the present invention recites:

13. A method of controlling the functions of an image processing apparatus using a remote control, the method comprising:

parsing a received remote control signal received from the remote control to determine whether the remote control signal is related to major function information or additional function information; (emphasis added)

displaying information for available additional functions on the image processing apparatus if the remote control signal contains a request for displaying the additional function information; (emphasis added)

performing a function of the image processing apparatus which corresponds to a selection signal in response to the selection signal being received from the remote control while the additional function information is displayed; and (emphasis added)

performing a function of the image processing apparatus which corresponds to the received remote control signal if the remote control signal is not requested for displaying the information of additional function, (emphasis added)

wherein the information of additional function is determined based on the frequency of use of the image processing apparatus. (emphasis added)

Clearly, the operations of the present claimed invention differ from the operations of Ohyama. For example, Ohyama does not recite performing a function of the image processing apparatus which corresponds to the received remote control signal if the remote control signal is

not requested for displaying the information of additional function, wherein the information of additional function is determined based on the frequency of use of the image processing apparatus, as is recited in, for example, amended claim 13.

Ohyama recites displaying a first level of a hierarchical menu in a first region of a screen of said television receiver, wherein a plurality of selection items corresponding to functions of said television receiver are displayed; designating one of said plurality of selection items from said first level of said hierarchical menu displayed on said screen of said television receiver; displaying a subordinate level of said hierarchical menu in a second region of said screen, wherein a plurality of control items corresponding to said designated selection item are displayed; selecting said designated selection item of said first level of said hierarchical menu; selecting one of said plurality of control items from said subordinate level of said hierarchical menu; and modifying said selected control item, whereby said functions of said television receiver corresponding to said designated selection item is controlled by modifying said selected control item. In contrast, in the present invention, the controller sets a mode for displaying additional function information; reads additional function information from the memory unit and sends the additional function information to an on-screen-display (OSD) processor; determines if a remote control signal has been received; determines, if a remote control signal has been received, if the remote control signal is a selection signal; determines if position information of the additional function information has been received; and displays a selected additional function information on a display unit.

Thus, it is respectfully submitted that amended independent claims 1, 13, 20 and 21 of the present invention are not anticipated under 35 U.S.C. §102(b) by Ohyama et al. (USPN 5,751,373). Since claims 2-6, 8-12, 14-17, and 19 depend from amended claims 1 and 13, respectively, claims 2-6, 8-12, 14-17, and 19 are not anticipated under 35 U.S.C. §102(b) by Ohyama et al. (USPN 5,751,373) for at least the reasons that amended claims 1 and 13 are not anticipated under 35 U.S.C. §102(b) by Ohyama et al. (USPN 5,751,373).

#### **REJECTION UNDER 35 U.S.C. §103:**

In the Office Action, at page 6, numbered paragraph 14, claims 7 and 18 were rejected under 35 U.S.C. §103(a) as being unpatentable over Ohyama et al. (USPN 5,751,373; hereafter, Ohyama) in view of Song (USPN 5,691,778; hereafter, Song). The reasons for the rejection are set forth in the Office Action and therefore not repeated. The rejection is traversed and reconsideration is requested.

Claims 7 and 18 have been cancelled. Hence, the rejection of claims 7 and 18 under 35 U.S.C. §103(a) is now moot.

**CONCLUSION:**

In accordance with the foregoing, it is respectfully submitted that all outstanding objections and rejections have been overcome and/or rendered moot, and further, that all pending claims patentably distinguish over the prior art. Thus, there being no further outstanding objections or rejections, the application is submitted as being in condition for allowance which action is earnestly solicited. At a minimum, this Amendment should be entered at least for purposes of Appeal as it either clarifies and/or narrows the issues for consideration by the Board.

If the Examiner has any remaining issues to be addressed, it is believed that prosecution can be expedited and possibly concluded by the Examiner contacting the undersigned attorney for a telephone interview to discuss any such remaining issues.

If there are any underpayments or overpayments of fees associated with the filing of this Amendment, please charge and/or credit the same to our Deposit Account No. 19-3935.

Respectfully submitted,

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